

NOT INTENDED FOR PUBLICATION IN PRINT

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION

BASF AKTIENGESELLSCHAFT,)	
)	
Plaintiff,)	
vs.)	
)	
REILLY INDUSTRIES INC,)	CAUSE NO. IP01-1936-C-Y/K
)	
Defendant.)	

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BASF AKTIENGESELLSCHAFT,)	
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vs.)	IP 01-1936-C-Y/K
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REILLY INDUSTRIES, INC.,)	
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Defendant.)	

ORDER ON DEFENDANT’S MOTION TO COMPEL¹

I. Background.

This cause is before the Court on a motion by Reilly Industries, Inc. (“Reilly”) seeking to compel Plaintiff BASF Aktiengesellschaft (“BASF”) to produce a single document relating to the interview of a patent office claims examiner. According to BASF’s privilege log, the document is a letter from Norman Oblon, an attorney with the law firm that originally prosecuted BASF’s ‘684 patent, to BASF regarding an “examiner interview and responding to Office Action along with proposed response.” [Def.’s Ex. L]. BASF withheld this document on the grounds that it was protected by the attorney-client privilege and the work product doctrine. [Def.’s Ex. L].

In support of its motion, Reilly proffers three arguments. First, Reilly argues that the letter is not at all privileged, asserting that the privilege extends only to communications and not to facts. Next,

¹The parties filed their briefs regarding the underlying motion to compel under seal. However, the Court does not believe that any of the information set forth in this order, or the conclusions reached in this order, may properly be deemed confidential and filed under seal. Accordingly, this order shall be filed by the Clerk without any restrictions on its dissemination.

Reilly argues that, even if the letter were privileged, BASF waived the privilege by voluntarily disclosing another confidential attorney-client communication on the same subject matter. Finally, Reilly asserts that the letter is not subject to the work product privilege because “[c]ourts have recognized that patent prosecution work performed outside of the context of litigation does not qualify as attorney work product.” [Docket No. 136, p. 7].

BASF maintains that “draft patent applications are privileged because they ‘necessarily reflect[] the communications between a client and his attorney as the attorney attempts to put forth the invention in the best light possible to protect a client’s legal right.’” [Docket No. 140, p. 4], quoting McCook Metals L.L.C. v. Alcoa Inc., 192 F.R.D. 242, 253 (N.D. Ill. 2000). Moreover, BASF argues that it did not waive the privilege because the document on which Reilly relies for its waiver argument simply does not contain legal advice or confidential information. Finally, in its brief, BASF does not assert (as it did in its privilege log) that the letter is attorney work product. As explained below, the Court finds that the disputed letter is protected by the attorney-client privilege, and therefore the work product issue need not be addressed.

II. Discussion.

The attorney-client privilege protects confidential communications made between a lawyer and client where legal advice is sought from a professional legal advisor in such capacity. Rehling v. City of Chicago, 207 F.3d 1009, 1019 (7th Cir. 2000), citing United States v. Evans, 113 F.3d 1457, 1461 (7th Cir. 1997). The inquiry into whether documents are subject to the privilege is a highly fact-specific one. “[T]he privilege must be made and sustained on a document-by-document basis. A blanket claim of privilege that does not specify what information is protected will not suffice.” United States v. White,

970 F.2d 328, 334 (7th Cir. 1992).

The Seventh Circuit adopted Professor Wigmore's standard for parties to assert the attorney client privilege. The elements are: (1) where legal advice was sought; (2) from a professional legal advisor in his capacity as such; (3) the communications relating to that purpose; (4) made in confidence; (5) by the client; (6) are at his instance permanently protected; (7) from disclosure by himself or by the legal advisor, (8) except the protection be waived. Evans, 113 F.3d at 1461, citing 9 J. Wigmore, Evidence §2292 (McNaughton rev. 1961). As the party seeking to establish the privilege, BASF bears the burden of demonstrating that all of the requirements for invoking the attorney-client privilege have been met. See Evans, 113 F.3d at 1461.

The cases cited by BASF in support of its claim that the document is protected by the attorney-client privilege are persuasive. In McCook Metals L.L.C. v. Alcoa Inc., 192 F.R.D. 242 (N.D. Ill. 2000), the district court found that drafts of patent applications were privileged. Specifically, the court noted:

These are drafts of the specifications, claims, and other parts of the patent application prepared by the attorney. A draft necessarily reflects the communications between a client and his attorney as the attorney attempts to put forth the invention in the best light possible to protect a client's legal right. A patent draft implicitly contains the legal opinion and advice of the attorney regarding the wording of technical specifications, claims, and prior art, and whether an item is included, all of which are necessary to secure a legal claim for the client. The art of creating verbal packages to persuade others, in this case the PTO, to find favorably for one's client, as opposed to simply dumping upon them a heap of detached, unorganized, technical blizzard of papers, is the work of an attorney.

McCook, 192 F.R.D. 252-53. The same reasoning applies to the instant matter. The letter at issue was drafted by BASF's outside patent counsel and pertained to an interview with a PTO examiner. In addition, the letter included a draft response to the PTO. The Court agrees with McCook and finds

that such communications implicitly contain legal opinion and advice.

Reilly is correct that communications between BASF's attorneys and the PTO are not privileged. However, Reilly misses the point. Reilly is not seeking to compel testimony or documents regarding BASF's attorney's communications with the PTO. Instead, Reilly seeks to discover what BASF's attorneys told BASF about their communications with the PTO. The distinction is subtle, but important. Oblon's letter to BASF regarding the examiner interview and proposed response necessarily contains legal advice on and interpretation of the examiner's comments. It is not just a factual recitation of what occurred during the interview. "While the application and communications with the patent office may themselves be a matter of public record and not privileged, the same cannot be said for the honing of technical specifications, claims, and decisions regarding inclusion or exclusion of information that occurs before the application itself." Smithkline Beecham Corp. v. Apotex Corp., 193 F.R.D. 530, 537 (N.D. Ill. 2000). The letter is protected by the attorney-client privilege.

Reilly next argues that, even if the letter is protected by the attorney-client privilege, BASF waived the privilege by producing in discovery a faxed letter from BASF to Oblon, Spivak, McClelland, Maier & Neustadt regarding the same subject matter (hereinafter "BASF 1013"). Reilly is correct that "the general rule is that voluntary disclosure of privileged communications waives the privilege as to all other communications dealing with the same subject matter." Vardon Golf Co., Inc. v. Karsten Mfg. Corp., 213 F.R.D. 528, 532 (N.D. Ill. 2003). BASF does not dispute that BASF 1013 was voluntarily disclosed. Nor does it dispute that BASF 1013 refers to the same subject matter. Instead, BASF maintains that information in BASF 1013 is not privileged and, therefore, no waiver occurred. The Court agrees with BASF.

In its entirety, the body of BASF 1013 states: “Thank you very much for your above fax. We are pleased to see that the Examiner in all likelihood intends to allow the claims. Please file your proposed response.” [Def.’s Ex. K]. This simply does not contain material protected by the attorney-client privilege. Nothing in BASF 1013 either seeks or provides legal advice. Its reference that the examiner “in all likelihood” will allow the claims is a fact that can be deduced from the examiner’s own interview summary record. [Def.’s Ex. A] (stating what BASF “will consider . . . which can overcome rejections of record”). Moreover, BASF’s instruction to “file your proposed response,” without more, does not implicate the attorney-client privilege. BASF 1013 does not suggest changes to the proposed response. In addition, once the “proposed response” was filed, it became public record. Finally, even if covered by the attorney-client privilege, the vague references to Oblon’s letter found in BASF 1013 would not, in this particular situation, result in a broad waiver of the privilege as to all communications regarding the examiner interview and the proposed response. In short, BASF did not waive the attorney-client privilege by producing BASF 1013 to Reilly.

III. Conclusion.

For the reasons set forth above, Reilly’s motion to compel is DENIED.

SO ORDERED this _____ day of July, 2004.

Tim A. Baker
United States Magistrate Judge
Southern District of Indiana

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